

### Remarks/Arguments

Claims 1 through 6, 9 through 14, 16 through 21, 23 through 28, 30 through 37, 40 through 47, and 49 through 62 are pending in this application. Claims 1, 5, 6, 9, 12, 16, 19, 20, 21, 23, 26, 27, 31, and 40 have been amended. Claims 7, 8, 15, 22, 29, 38, 39, and 48 have been canceled. Claims 49 through 62 were previously withdrawn.

The Office Action asserts that claims 1 through 6 and 13 are anticipated by U.S. Patent No. 6,101,366 to Castillo or U.S. Patent No. 4,860,364 to Giannini.

Independent claim 1 recites a toy garment, including a sound generating member having a first actuator switch and a second actuator switch. The sound generating member emits a sound in response to actuation of the first actuator switch and actuation of the second actuator switch. The second actuator switch is activated by motion of the sound generating member.

Castillo discloses a sound belt for diapers including a removably mounted overlay with pictorial representations that cooperatively coincide with switches, permitting a baby to play a predetermined sound by pressing one of the pictorial representations.

Castillo fails to disclose or suggest a toy garment that emits a sound in response to the motion of a sound generating member. Thus, Castillo does not anticipate claim 1. Claims 2 through 6 and 13 depend from independent claim 1 and are not anticipated by Castillo for at least the reason given above regarding claim 1.

Giannini discloses a sound generating outer garment including a switch with a flexible and conductive first outer lamina and a flexible and insulated second outer lamina. Interposed between the two outer laminas is a flexible and resilient insulating cushion. The cushion has a number of holes formed through its thickness.

Conductive projections are positioned on the second outer lamina in alignment with the holes formed in the cushion. The projections are electrically joined together. Consequently, if sufficient pressure is exerted anywhere on either outer lamina, at least one of the projections will contact the first outer lamina and complete a circuit through the switch. The switch may be connected to a sound generating circuit.

Giannini fails to disclose or suggest a toy garment that emits a sound in response to the motion of a sound generating member. The sound generating circuit disclosed by Giannini is part of a main control circuit. See column 3, lines 59 through 61. As shown in FIG. 1 of Gianinni, the sound generating circuit is not located in a central region of the outer garment, and is not integral with the switches. Sound is emitted in response to a force applied to the switches, not in response to the motion of the sound generating circuit. See column 5, lines 11 through 14. Thus, Giannini does not anticipate claim 1. Claims 2 through 6 and 13 depend from independent claim 1 and are not anticipated by Gianinni for at least the reasons given above regarding claim 1.

The Office Action asserts that claims 16, 18, 19, 28, 30, 31, 34, 36, and 38 are anticipated by U.S. Patent No. 3,670,321 to Savides.

Independent claim 16 recites a toy garment including a sound generating member adapted to be removably inserted into a pocket and having, among other things, a first actuator switch, and a motion activated trigger comprising a spring cylinder.

Independent claim 31 recites a toy garment including a sound generating member, a first actuator switch and a second actuator switch. The first actuator switch is actuated and deactuated by manual depression of the first actuator switch. The second actuator switch is actuated by motion of the sound generating member.

Savides discloses a personal noise making and alarm signal device comprising two concave parts opposingly connected together at their peripheries. Within the two concave parts is an electric sound producing device and a push button switch that activates and deactivates the sound producing device.

Savides fails to disclose or suggest a toy garment including a motion activated trigger, let alone a motion activated trigger comprising a spring cylinder. The push button switch of Savides is adapted to be "pushed at one time to effect actuation of the loud speaker" and "pushed at another time to effect the disengagement of the contacts of the battery to arrest the noise." See column 1, lines 12 through 16. Savides does not mention or even suggest the use of a motion activated trigger, as recited in claim 16, or a second actuator actuated by motion of a sound generating device, as recited in claim 31. Thus, claims 16 and 31 are not anticipated by Savides.

Claims 18, 19, 28 and 30 depend from independent claim 16 and are not anticipated by Savides for at least the reasons given above regarding claim 16.

Claims 34 and 36 depend from independent claim 31 and are not anticipated by Savides for at least the reasons given above regarding claim 31. Claim 38 has been canceled, thus the rejection is moot in regard to this claim.

The Office Action asserts that claims 7 through 12 and 14 are obvious in view of Castillo or Giannini. Claims 7 and 8 have been canceled, thus any rejection regarding these claims is now moot.

The Office Action has failed to establish a *prima facie* case of obviousness in regard to claims 9 through 12 and 14.

Claims 9 through 12 depend from independent claim 1 and therefore each include the element of a second actuator switch actuated by the motion of the sound

generating member. As indicated above, neither Castillo nor Giannini anticipates independent claim 1. The Office Action indicates that it “would have been obvious to one having ordinary skill in the art at the time the invention was made to use a motion switch for the device of Castillo or Giannini for the purpose of producing sounds upon the motion of an individual.” This assertion by the Office Action indicates that neither Castillo nor Giannini discloses or suggests a motion switch. The Office Action thus bases the rejection solely on the unsupported assumption that “it is well known in the art to use motion switches for toys.” It is never appropriate to base a rejection solely on common knowledge in the art without evidentiary support in the record. MPEP 2144.03. The references cited by the Office Action do not disclose or suggest all of the elements found in claims 9 through 12. Consequently, a *prima facie* case of obviousness regarding claims 9 through 12 has not been established; the cited claims are therefore patentable over both Castillo and Giannini.

Additionally, both Castillo and Giannini teach away from the invention of claims 9 through 12. Giannini discloses outerwear that produces musical sounds in response to bodily movements. Preferably, the outerwear includes a plurality of switches, each one of the switches uniquely corresponding to one of a plurality of sounds. In other words, the wearer selectively actuates the individual switches in a given manner to produce a sequence of sounds. Emitting a sound in response to the movement of the sound producing circuit, rather than in response to the wearer’s bodily movements, would defeat the stated object of the invention in Giannini.

The main object of Castillo is to provide a sound belt for diapers that can help a child communicate his desires or preoccupations. The child accomplishes this communication by pressing one of the pictorial representations on the sound belt, which then generates a predetermined sound corresponding to the pictorial representation. Emitting a sound in response to the movement of the sound belt would not allow the child to communicate his needs by pressing a pictorial representation to produce a sound, and in fact would frustrate that purpose.

Claim 14 depends from independent claim 1 and recites that the outer housing of the sound generating member is high impact polystyrene porene. The Office Action admits that both Castillo and Giannini fail to disclose a device made of high impact polystyrene porene, but indicates that the use of this material "would have been an obvious matter of design choice" to a person having ordinary skill in the art. The mere fact that a worker in the art could have used high impact polystyrene porene to meet the terms of claim 14 is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of the present application, to make the necessary changes. Because the Office Action has failed to show a motivation to use high impact polystyrene porene in either the device disclosed in Castillo or Giannini, a *prima facie* case of obviousness regarding claim 14 has not been established. Claim 14 is thus patentable over both Castillo and Giannini.

The Office Action asserts that claims 17, 21 through 27, 32, 39 through 45, and 47 are obvious in view of Savides. Claims 17 and 21 through 27 depend from independent claim 1, meaning that each of the cited claims includes a sound producing member that emits a sound in response to the motion of the sound producing member. Claims 32, 40 through 45, and 47 depend from independent claim 31, meaning that these claims include the element of an actuator switch that is actuated by motion of a sound generating member. Claims 22 and 39 have been canceled, thus any rejection of these claims is now moot.

The Office Action admits that Savides fails to disclose a motion switch. The Office Action has failed to establish a *prima facie* case of obviousness regarding claims 17, 21, 23 through 27, 32, 40 through 45, and 47. As support for the obviousness rejection, the Office Action relies solely on the unsupported assumption that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a motion switch for the device of Savides." Again, it is inappropriate to base a rejection solely on common knowledge in the art without

evidentiary support in the record. A prima facie case of obviousness requires that the cited references disclose or suggest all of the claimed limitations. Because the Office Action has failed to produce any references that disclose or suggest a motion switch activated by the motion of a sound generating member, as found in claims 17, 21, 23 through 27, 32, 40 through 45, and 47, a prima facie case of obviousness regarding these claims has not been established.

Finally, the Office Action asserts that claims 20 and 37 are rendered obvious by Savides in view of Castillo.

Savides and Castillo, either individually or in combination, do not disclose or suggest each element in either 20 or 37. The Office Action argues that “Savides teaches most of the elements of the claimed invention except for prerecorded sounds” and that “it would have been obvious to one having ordinary skill in the art to incorporate prerecord[ed] sounds as suggested by Castillo.” However, to establish a prima facie case of obviousness, the cited references must disclose or suggest all of the elements of the claims.

Claim 20 depends from independent claim 16, which recites a sound generating member having a motion activated trigger comprising a spring cylinder. Neither Savides nor Castillo discloses or suggests a motion activated trigger, let alone a motion activated trigger comprising a spring cylinder. Thus, Savides and Castillo, either individually or in combination, do not render claim 20 obvious.

Claim 37 depends from independent claim 31, which recites a sound generating member having a second actuator switch actuated by motion of the sound generating member. Savides and Castillo, either individually or in combination, fail to disclose or suggest an actuator switch actuated by motion of a sound generating member. Consequently, claim 37 is patentable over Savides and Castillo.

In view of the above, Applicants respectfully submit that all claims presented in this application are in condition for allowance. Accordingly, Applicants respectfully request favorable consideration and that this application be passed to allowance. In the event that further clarification is required prior to allowance, Applicants respectfully request that the Examiner contact Applicants' undersigned attorney.

Respectfully submitted,



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